

R E M A R K S

Reconsideration of the present application, as amended, is respectfully requested.

The January 15, 2002 Office Action and the Examiner's comments have been carefully considered. In response, claims are amended and added, an interview was conducted with the Examiner, and remarks are set forth below in a sincere effort to place the present application in form for allowance. The amendments are supported by the application as originally filed. Therefore, no new matter is added.

INTERVIEW

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The courtesy of Examiner Basinger in granting an interview in connection with this application is acknowledged and appreciated. The interview took place on April 2, 2002. During the interview, applicant's attorney, Robert Michal, discussed the present claimed invention and USP 3,179,397 (Cleereman et al) with the Examiner. Applicant's attorney discussed differences between the present invention and Cleereman et al. Specifically applicant's attorney pointed out that while Cleereman et al teach a wire screen over a middle area of a dock bumper which is the area most likely to receive the greatest impact, Cleereman et al do not disclose, teach or suggest disposing the mesh entirely

about the flotation material to provide strength to the entire device. Examiner Basinger agreed that if claims 1 and 21 were amended to recite that the flexible mesh is disposed entirely about the flotation material the claims would define over Cleereman et al.

It was agreed that applicant would submit a formal written response to the January 15, 2002 Office Action and amend claims 1 and 21 as discussed during the interview.

DRAWINGS

In the Office Action the Examiner objects to the drawings as originally filed. In response, new formal drawings are submitted which include uniformly thick, well-defined, clean and durable lines, numbers and letters as requested by the Examiner. In view of the submission of the new formal drawings, reconsideration and withdrawal of the objection to the drawings are respectfully requested.

PRIOR ART REJECTIONS

In the Office Action claims 1, 3, 4, 17 and 21 are rejected under 35 USC 102(b) as being anticipated by USP 3,179,397 (Cleereman et al). Claims 1-4 and 6-21 are rejected under 35 USC 103 as being obvious and unpatentable over USP 5,480,332

(Cynamon) in view of Cleereman et al. Claim 5 is rejected under 35 USC 103 as being obvious and unpatentable over Cynamon and Cleereman et al, and further in view of USP 5,636,900 (Wilkie et al).

In response, claims 1 and 21 are amended to more clearly recite that the flexible mesh is disposed entirely about the flotation material. Support for this amendment can be found from Fig. 2 and the description beginning at page 8, line 3 - page 9, line 15 of the present application. Fig. 2 shows that the flexible mesh covers the outer surface of a cross-section of the flotation material and page 8, lines 13-17 disclose a suitable flexible mesh as being a nylon tubular gauze. At page 9, lines 12-15 it is explained that it is preferable that the mesh is secured directly to the straps which exit ends of the flotation material.

As explained to Examiner Basinger during the interview, Cleereman et al teach an improved bumper to be used on docks as a cushion for boats. Cleereman et al teach that in order to provide a tougher bumper, a wire screen can be sealed between the foam body and the skin along the middle area of the bumper which portion is most likely to receive the greatest impact. Cleereman et al do not, however, disclose, teach or suggest that the wire screen is disposed entirely about the foam body.

That is, the present claimed invention as defined by claim 1 is patentable over Cleereman et al because Cleereman et al do not disclose, teach or suggest, inter alia:

a flexible mesh disposed entirely about said flotation material, said flexible mesh being in contact with an outer surface of the flotation material (see claim 1, lines 3-5).

Claim 21 is amended in a manner similar to the amendment to claim 1. Claim 21 is patentable over Cleereman et al for reasons, inter alia, set forth above in connection with claim 1.

With regard to the rejection of claims 1-4 and 6-21 as being obvious over Cynamon in view of Cleereman et al, the comments set forth above in connection with Cleereman et al with regard to the 102(b) rejection are incorporated herewith. Cynamon teaches a multiple victim rescue device. As acknowledged by the Examiner, Cynamon does not disclose, teach or suggest a flexible mesh disposed entirely about the flotation material wherein the flexible mesh is in contact with an outer surface of the flotation material as recited in claims 1 and 21 nor would it have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Cynamon with a mesh disposed entirely about the flotation material as recited in claims 1 and 21 based upon the teaching of Cleereman et al which

teaches to provide the mesh only over portions of a bumper that receive the greatest impact from boats so as to provide added strength to the foam body.

Applicant also respectfully states that the references cited by the Examiner are not properly combinable and therefore it would not have been obvious for a person of ordinary skill in the art at the time the invention was made to look at such diverse fields of application as covered by Cynamon (multiple victim rescue device) and Cleereman et al (dock bumper) to arrive at a solution to a problem not suggested by any one of the references. Even further, there is no motivation to combine the references in the manner asserted by the Examiner. Therefore the rejection is improper and must fail.

An Examiner cannot arbitrarily pick and choose elements from the prior art in a piecemeal fashion to construct the claimed invention, without some direction from the prior art. In re Donovan and Ryan, 184 U.S.P.Q. 414, 420 (C.C.P.A. 1971). It appears, however, that this is exactly what the Examiner has done. It is respectfully submitted that combining the references as suggested by the Examiner could only result from impermissible hindsight gained from utilizing applicant's own disclosure to construct the present invention from bits and pieces of the prior art. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 U.S.P.Q.

303, 312-313 (C.A.F.C. 1983); In re McLaughlin, 170 U.S.P.Q. 209 (C.C.P.A. 1971).

As succinctly stated by the Board of Appeals:

In our view the here claimed subject matter would not have been obvious within the meaning of 35 U.S.C. 103 based solely on the Baney Patent. As correctly urged by the appellant, and as apparently recognized by the Examiner, in order to meet the terms of the claims on appeal, the elements of the Baney device would have to be arranged in a manner different from that disclosed by Baney. The elements of the reference would also be required to coact differently from the way they coact in the arrangement disclosed by the reference. The mere fact that a worker in the art could rearrange the part of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of the appellant's specification, to make the necessary changes in the reference device. The Examiner has not presented any evidence to support the conclusion that a worker in this art would have had any motivation to make the necessary changes in the Baney device to render the here claimed device unpatentable. We additionally note that the interrelationship and the relative movements of the various elements required by the claims on appeal would not be met by the Baney device even if reconstructed as suggested by the Examiner. Ex parte Chicago Rawhide Manufacturing Co., 223 U.S.P.Q. 351, 353 (Bd. Pat. App. 1984). (Emphasis added)

In this regard, it has been held that, in considering the prior art references, the relevant consideration is what these references, when considered together, make obvious to one of ordinary skill in the art. In re Mapelsdon, 141 U.S.P.Q. 30, 32 (C.C.P.A. 1971). There is no disclosure or suggestion to modify

Bertacchi to arrive at the present claimed invention.

"Modification unwarranted by the disclosure of a reference is improper." Carl Schenck A.G. v Nortron Corporation, 218 U.S.P.Q. 698, 702 (C.A.F.C. 1983). The Examiner's failure to indicate anywhere in the record any reason or basis for altering of the reference militates against the rejection. Ex parte Kaiser, 194 U.S.P.Q. 47 (Bd. Pat. App. 1975).

It is not the mere possibility of combining the references that must be taken into consideration, but rather there must exist some logical reason or some suggestion in the art for combining the references. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983); ACS Hospital Systems, Inc. v. Montefiore Hospital et al.; 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984); In re Imperato, 179 U.S.P.Q. 730, 732 (C.C.P.A. 1973). The Examiner has not disclosed any valid reason to combine the references and there certainly is no logical reason to do so.

Not only do the cited references fail to disclose or suggest the claimed invention, but they also fail to disclose or suggest the problems which required the applicants to arrive at the present invention. As the Court of Customs and Patent Appeals stated in In Re Sponnoble, 160 U.S.P.Q. 237, 243 (C.C.P.A. 1969):

A patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 USC 103 (cases cited). The Court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statement; that is we must view the prior art without reading into that art applicant's teaching (cases cited). The issue, then, is whether the teachings of the prior art, in and of themselves and without the benefit of applicant's disclosure, make the invention as a whole, obvious.

The shortcomings of prior art which are overcome by the present invention were not even contemplated by the cited references. Therefore, the claimed invention must be patentable thereover.

Even if the cited references are properly combinable, their disclosure does not teach or suggest the limitation recited in claims 1 and 21 as explained above.

In view of the foregoing, claims 1 and 21 and claims 2-4 and 6-20 which are ultimately dependent on claim 1 are patentable over Cynamon and Cleereman et al under 35 USC 102 as well as 35 USC 103.

Claim 5 is patentable in view of its dependence on claim 1.

Claims 9, 10, 11, 12, 13, 19 and 20, inter alia, are separately patentable over the cited references because the claimed features are not disclosed, taught or suggested in the

cited references. Along these lines the Examiner has not pointed to specific portions of the cited references to support his rejection of claims 9-13, 19 and 20.

NEW CLAIMS

New claims 22-26 are added to the present application. Claim 22 is an independent claim and includes the features recited in claims 1, 6 and 9. Claim 23 is an independent claim and includes the features recited in claims 1, 6 and 10. Claims 22 and 23 are patentable over the prior art of record because the references do not disclose, teach or suggest all of the limitations recited in new claims 22 or 23.

Claims 24-26 are dependent claims. Claim 24 is similar to claim 11 but is dependent of claim 23, claim 25 is similar to claim 12 but is dependent on claim 24, and claim 26 is similar to claim 13 but is dependent on claim 23.

Submitted herewith is a check in the amount of \$87.00 for the presentation of one (1) independent claim and five (5) total claims above the highest number of claims for which payment was previously made (the present invention having been filed with 21 total claims, two of which are independent and the amended application including 26 total claims, four of which are independent). If any additional fees are due or if any

overpayment has been made, please charge or credit our Deposit Account No. 06-1378 for such sum.


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If the Examiner disagrees with any of the foregoing, the Examiner is respectfully requested to point out where there is support for a contrary view.

Entry of the amendment, allowance of the claims, and the passing of the application to issue are respectfully solicited.

If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the undersigned at the telephone number given below for prompt action.

Respectfully submitted,


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Encs.: (1) Copy of amended claims showing changes made thereon
(2) Letter to the Official Draftsperson
(3) Check for \$87.00